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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/370,453	08/09/99	DENNEY	D GENITOPE-038

HM12/1019  
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EXAMINER

BANSAL, G

ART UNIT

PAPER NUMBER

1642

DATE MAILED:

10/19/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/370,453

Applicant(s)

Derney

Examiner

Geetha Bansal

Group Art Unit

1642

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE -3- MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

☒ Responsive to communication(s) filed on 6/18/01

☒ This action is **FINAL**.

- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

☒ Claim(s) 1, 3-6, 21-32 is/are pending in the application.

Of the above claim(s) 21-24 is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1, 3-6, 25-32 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
  - ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
  - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4, 8

☐ Interview Summary, PTO-413

☒ Notice of Reference(s) Cited, PTO-892

☐ Notice of Informal Patent Application, PTO-152

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Other \_\_\_\_\_

Office Action Summary

Art Unit: 1642

### **DETAILED ACTION**

1. Applicant's remarks and amendment filed June 18, 2001 (Paper No: 6/B) is acknowledged. Claims 1, 3, 4, 5, 6 have been added. Claims 1, 3-6, 25-32 are being examined.

### ***Response to Arguments***

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Rejection of claims 1, 3-6, and (this now applies to new claims 25-32) under 35 U.S.C. 103(a) are maintained as set out in the previous office action. New claims are drawn to the same product as the multivalent vaccine compositions of claims 1-6, though they have been presented as a product by a unique process. Applicant's arguments have been considered but they are not deemed to be persuasive. Applicant argues that there is no motivation provided in the combination of references to formulate the claimed subject matter. It is submitted that the person of ordinary skill in the art is an immunologist specially one with knowledge in the area of B cells and antibodies (the present Examiner in this case also happens to have had experience working in these fields) would have found it obvious to make polyvalent vaccines- in this case a vaccine composition comprising several different Ig clones because recognition of different epitopes or antigens would be very advantageous to killing a wider range of cells. This is information that would have been extremely obvious to one of ordinary skill in the art. Applicant is referred to a basic textbook of Immunology such as Fundamental Immunology Ed. Bill Paul 1989- relevant pages are included with this action (this is not a new reference or new grounds of rejection but merely supporting documents) which indicate that one of ordinary skill in the art would have found it obvious to consider B cell lymphomas as being polyclonal. Further, inherently an immunoglobulin molecule has associated with it more than one idiotope, but the understanding here was that the different idiotopes claimed were supposed to belong to different

Art Unit: 1642

immunoglobulins- hence the rejection addressed the issues of different B cells and the antibodies produced by them. In response to applicant's argument that there is no suggestion to combine the teachings of the references with knowledge obvious to one of ordinary skill in the art, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, one of ordinary skill in the art would have known that B cells produce a single Ig species and that in a B cell lymphoma, a polyclonal involvement of different B cells occurs. This would instigate one of ordinary skill in the art to produce a polyvalent vaccine that would possibly target the different B cell clonotypes that are involved in the disease.

5. No claims are allowed.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for response to this final action is set to expire **THREE MONTHS** from the date of this action. In the event a first response is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for response expire later than **SIX MONTHS** from the date of this final action.

Art Unit: 1642


7. Papers related to this application may be submitted to Group 1640 by facsimile transmission. Papers should be faxed to Group 1640 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center telephone number is (703) 308-4242 or (703) 305-3014.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Geetha P. Bansal whose telephone number is (703) 305-3955. The examiner can normally be reached on Mondays to Fridays from 7:00am to 4:30pm and alternate Wednesdays from 7:00am to 3:30pm. A message may be left on the examiner's voice mail service.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Anthony Caputa, can be reached on (703) 308- 4995.

9. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

October 8, 2001

A handwritten signature in black ink, appearing to read "Bansal", is written over a horizontal line.

GEETHA P. BANSAL  
PRIMARY EXAMINER